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	Group Art Unit	1771
	Examiner Name	J. Guarriello
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants : JORN LEIBER ET AL.
Serial No. : 08/976,820
Filed : November 25, 1997
For : USE OF AN ADHESIVE TAPE SECTION
Art Unit : 1771
Examiner : J. Guarriello

May 27, 2003

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**APPELLANTS' REQUEST FOR REHEARING
PURSUANT TO 37 CFR § 1.197(b)**

SIR:

Appellants respectfully request rehearing of the decision of the Board of Patent Appeals and Interferences (hereinafter "the Board") dated March 26, 2003 (hereinafter "the decision").

Appellants believe that the Board misapprehended or overlooked the following points in rendering the decision:

- A person having ordinary skill in the art could have inferred from the teachings of Luhmann, U.S. Patent No. 5,725,923 (hereinafter "Luhmann"), at column 2, line 65, to column 3, line 1, that "grip tabs can be provided to each and every side or

some of the sides of a given geometrically shaped adhesive tape to substantially or fully surround the tape's edge."

- It is well within the ambit of one of ordinary skill in the art to provide an appropriate number of grip tabs, including the number of grip tabs corresponding to the sides of given geometrically shaped adhesive tapes.
- The ability of one of ordinary skill in the art to infer the invention or the fact that the invention is within the ambit of one of ordinary skill in the art amounts to the requisite suggestion of the invention which is required for *prima facie* obviousness.

In greater detail:

1. **A person having ordinary skill in the art would *not* have inferred from the teachings of Luhmann at column 2, line 65, to column 3, line 1, that "grip tabs can be provided to each and every side or some of the sides of a given geometrically shaped adhesive tape to substantially or fully surround the tape's edge."**

There appears to be agreement on the following points:

1. The present claims require a polygonal or circular shaped adhesive tape section.

2. In the case of a polygonal shaped adhesive tape section, the present claims require the same number of grip tabs as there are sides of the polygon.
3. In the case of a circular shaped adhesive tape section, the present claims require a single grip tab surrounding a circular shaped adhesive core.
4. Luhmann teaches an adhesive tape section, specifically, a quadrangle having two grip tabs.
5. Luhmann fails to teach a number of grip tabs equal to the number of sides of the adhesive tape section, specifically, four grip tabs in the case of a quadrangle.
6. Luhmann also fails to teach shapes of adhesive tape sections other than quadrangles.
7. Cole teaches adhesive tape sections of various shapes.
8. Cole also does not teach a number of grip tabs equal to the number of sides of a polygonal shaped adhesive tape section.
9. In the case of a circular shaped adhesive tape section, Cole also does not teach a single grip tab surrounding a circular shaped adhesive core.

Appellants perceive the following gaps between the combination of Luhmann and Cole and the instant claims:

1. While the combination of Luhmann and Cole may suggest polygonal shaped adhesive sections, the combination of Luhmann and Cole does not teach or suggest the provision of a number of grip tabs equal to the number of sides of the polygon.
2. While the combination of Luhmann and Cole may suggest a circular shaped adhesive section, the combination of Luhmann and Cole does not teach or suggest the provision of a single grip tab surrounding a circular shaped adhesive core.

To bridge these gaps, the Board makes findings in the paragraph bridging pages 6-8. The Board begins as follows:

“As acknowledged by the appellants (Brief, page 16), Luhmann exemplifies a plurality of grip tabs attached to *two* different sides of a *quadrangle* shaped adhesive tape. See also Luhmann, columns 5 and 6, example 8. [Emphasis added.]”

Thus, for a quadrangle having **four** sides, Luhmann teaches the provision of **two** grip tabs, which relationship does not meet the terms of the instant claims.

The Board then finds as follows:

“We find that Luhmann also broadly discloses (column 2, line 65 to column 3, line 1) that:

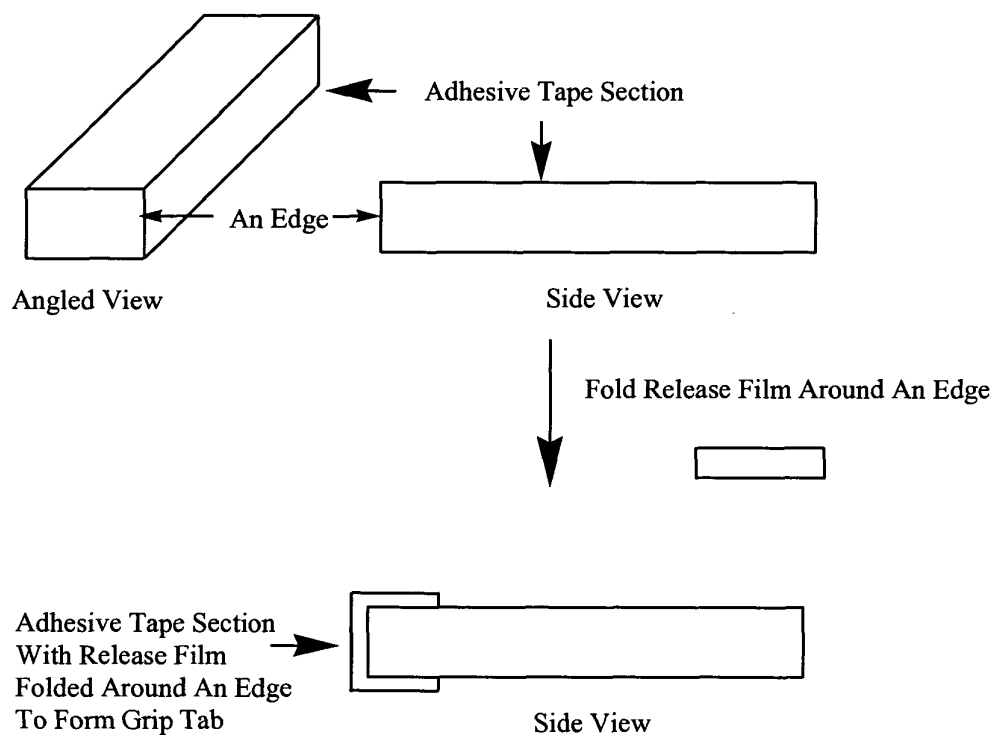
[A] tab is recommended in each case to enable easier pulling on the residue. Such a tab can be designed, in particular, so the non-adhesive areas extend around *an* edge of the piece of adhesive film.

It *can be inferred* from these teachings that grip tabs can be provided to each and every side or some of the sides of a given geometrically shaped adhesive tape to substantially or fully surround the tape’s edge. [Again, emphasis added.]”

A person having ordinary skill in the art would not have inferred from Luhmann’s teachings at column 2, line 65 to column 3, line 1, that grip tabs can be provided to each and every side or some of the sides of a given geometrically shaped adhesive tape to substantially or fully surround the tape’s edge. What a person having ordinary skill in the art would clearly understand from Luhmann at column 2, line 65, to column 3, line 1, is that Luhmann is describing the formation of a *single* grip tab on a *single* edge of the quadrangle by folding a piece of non-adhesive material around that edge. Thus, for example, for a quadrangle having four sides, Luhmann is here describing the construction of a grip tab on only *one* of the four sides. This process is described in greater detail in Example 8 in Luhmann at column 5, lines 65-67:

“[W]here 5 mm of the release films are folded around the adhesive film at each end of the adhesive films and thus form tabs.”

This is shown graphically for *one* end as follows:



In short, whereas Luhmann refers to “an edge,” the Board improperly reads this as “all edges” of a polygon to substantially or completely surround the tape. However, reading Luhmann, as a person having ordinary skill in the art would understand it, a person having

ordinary skill in the art would not have inferred from these teachings that grip tabs can be provided to each and every side or some of the sides of a given geometrically shaped adhesive tape to substantially or fully surround the tape's edge. Further, such person would not have understood how provision of grip tabs to only some of the sides would substantially or fully surround the tape's edge.

In further support of this position, there is attached the Declaration of Dr. Bernd Luhmann, who is an inventor of the instantly claimed subject matter and also the Bernd Luhmann who is the first named inventor of the Luhmann patent. The Luhmann Declaration is responsive to the Board's findings, and is, thus, believed relevant and timely submitted. Dr. Luhmann avers in numbered paragraphs 14 and 15 of his declaration that:

"I assert that the Board misapprehended that one of ordinary skill in the art would 'infer' that a recitation wherein '*...a tab is recommended in each case to enable easier pulling on the residue, a tab can be designed, in particular, so that non-adhesive areas extend around an edge of the piece of adhesive film, for example a few millimeters beyond the adhesive area beneath.*' would be construed to be suggestive 'that grip tabs can be provided to each and every side or some of the sides of a given geometrically shaped adhesive tape to substantially or fully surround the tape's edge.' (from page 7, lines 3-6 of the Board's decision)

"The broadest recitation is singular ('*...a tab is recommended...a tab can be designed*'), an embodiment of this recitation is still singular ('*in particular, so that non-adhesive areas extend around an edge of the piece of adhesive film*) and an example of this embodiment is directed towards the practice of removing residue

and is not directed toward releasing the bond between an object and a substrate (*for example a few millimeters beyond the adhesive area beneath*). None of these disclosures would ‘infer’ to one of ordinary skill in the art to use multiple tabs equaling the number of edges, or to supply grip tabs for each and every edge. Clearly, the portion of Luhmann relied on by the Board is only talking about the design of a single tab on a single edge. The same type of tab could, of course, be placed at each an every edge, but there is no teaching or suggestion in Luhmann to do so, so this aspect of the present invention cannot be inferred from Luhmann.”

Respectfully, the Board misapprehended Luhmann’s teachings at column 2, line 65, to column 3, line 1, and, in so doing, improperly found the present claims to have been *prima facie* obvious.

2. **It is not well within the ambit of one of ordinary skill in the art to provide an appropriate number of grip tabs, including the number of grip tabs corresponding to the sides of given geometrically shaped adhesive tapes.**

The Board also bridges the gaps between the combined teachings of Luhmann and Cole and the instant claims by finding that:

“[F]rom our perspective, it is *well within the ambit* of one of ordinary skill in the art to provide an appropriate number of grip tabs, including the number of grip tabs corresponding to the sides of given geometrically shaped adhesive tapes, to provide

contingent bases in case of failure of one or more grip tabs in removing the adhesive tapes since Luhmann teaches that the grip tabs can be pulled at any angle and are used to remove the residues of the adhesive tapes as indicated *supra*. [Emphasis added.]”

However, the grip tabs are a feature of Luhmann’s invention which he himself indicates “should not be necessary.” See, Luhmann at column 1, lines 62-63 (“In particular, a tab for pulling the adhesive film out of the bond join (sic) should not be necessary.”) Accordingly, a person having ordinary skill in the art arguably lacks motivation to provide the two grip tabs that Luhmann expressly teaches for a quadrangle, let alone to provide two additional grip tabs on the two remaining sides.

Dr. Luhmann avers in numbered paragraphs 11 and 12 of his declaration as follows:

“In the reasons supporting the combination of Luhmann and Cole, the Board stated on page 7 that ‘it is well within the ambit of one of ordinary skill in the art to provide an appropriate number of grip tabs...***to provide contingent bases in the case of failure of one or more grip tabs in removing the adhesive tapes*** since Luhmann teaches that the grip (sic) tabs can be pulled at any angle and are used to remove the residues of the adhesive tapes as indicated *supra*.’ (bold and italics added for emphasis)

“However, there is no teaching which can be gleaned from the combination of Luhmann and Cole that this is necessary or desired.

Moreover, the tabs of Luhmann function to remove residue not toward releasing the bond between an object and a substrate. In fact, when reading the entire paragraph from Luhmann (col. 2, lines 57 - col. 3, line 3) which the Board merely cited four lines (which is shaded below), one of ordinary skill in the art would have read the Luhmann reference to be at best rather ambivalent about the need for *any* tabs, much less multiple tabs:

‘In these embodiments according to the invention with an adhesive film of the rather more classical type of a self-adhesive composition as widely employed for adhesive tapes, the separation of the pulled-apart parts is less easy after breaking the bond. *However, this is relatively unimportant for some applications, in particular if the residues can remain on the substrates without causing any problems.* However, if in this and other cases the residues are to be more easily removable, a tab is recommended in each case to enable easier pulling on the residue. Such a tab can be designed, in particular, so that non-adhesive areas extend around an edge of the piece of adhesive film, *for example a few millimeters beyond the adhesive area beneath.*’”

Respectfully, the Board misapprehended Luhmann’s teachings at column 2, line 65, to column 3, line 1, in finding the provision of a number of grips tabs equal to the number of sides of a polygon and, in so doing, improperly found the present claims to have been *prima facie* obvious.

3. **The ability of one of ordinary skill in the art to infer the invention or the fact that the invention is within the ambit of one of ordinary skill in the art does not amount to the requisite suggestion of the invention which is required for *prima facie* obviousness.**

The concept of *prima facie* obviousness entails a finding that the prior art would have suggested to persons skilled in the art that they should make and use the claimed invention and also have revealed to persons skilled in the art a reasonable expectation of success in making and using the claimed invention. The Board's own precedents, for example, *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (BPAI 1993), make clear that findings that persons skilled in the art "can infer" the invention or that the invention was "within the ambit of persons skilled in the art" do not rise to the level of the requisite suggestion to make and use the claimed invention. In *Levengood*, the Board explained:

"At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the requisite skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. That which is within the capabilities of one skilled in the art is not synonymous with obviousness. That one can *reconstruct* and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the

art to combine the teachings of the references to make the claimed invention. [Citations omitted and emphasis in original.]”

Neither the Board nor the Examiner pointed to anything in either Luhmann or Cole or in their combination that would have suggested to persons skilled in the art that they should:

1. Provide a polygonal shaped adhesive section with a number of grip tabs equal to the number of sides of the polygon.
2. Provide a circular shaped adhesive section with a single grip tab surrounding a circular shaped adhesive core.

These features of the present invention are not fairly taught or suggested by the combination of Luhmann and Cole. These features of the present invention can only be gleaned from the instant specification, and, therefore, the Board has improperly used Appellants’ specification against them. As stated in *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999):

“...Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. **Close adherence to this methodology is especially important in the case of less technologically complex inventions**, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome

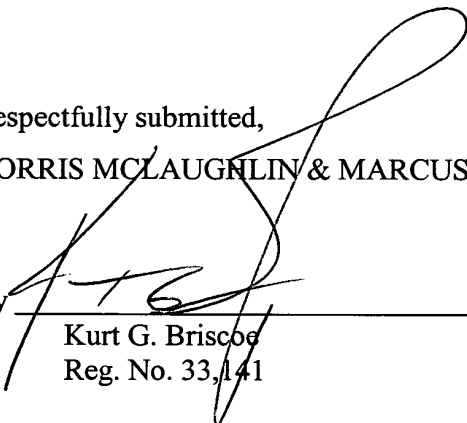
wherein that which only the inventor taught is used against the teacher.'...**Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.** [Emphasis added.]”

Respectfully, a *prima facie* case of the obviousness of the instant claims has not been made out. Accordingly, the final rejection should be reversed.

Conclusion

For the foregoing reasons, Appellants respectfully request that the Honorable Board reconsider the decision dated March 26, 2003, and reverse the final rejection.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By 
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By 
Kurt G. Briscoe



19. Acknowledgment

20. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that the foregoing statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: May, 16th 2003 By Bernd Lühmann
Bernd Lühmann